

Appl. No. 10/751,362  
Docket No. AA611  
Amdt. dated November 18, 2010  
Reply to Office Action mailed on August 18, 2010  
Customer No. 27752

## REMARKS

### Claim Status

Claims 1, 9, 11, 22-30, and 32-34 are pending in the present application, with claims 25-29 being withdrawn from consideration. No additional claims fee is believed to be due.

Claim 1 is amended herein to further clarify that the graphics are printed directly on the backsheet of an absorbent article by reciting that the microporous film material extends from the first waist region to the second waist region. It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

### Rejections Under 35 U.S.C. § 103 over Brandon in view of Pargass and Yeo

In the Office Action, claims 1, 9, 11, 22-24, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,818,719 issued to Brandon et al. (hereinafter "Brandon") in view of U.S. Patent No. 5,503,076 issued to Yeo et al. (hereinafter "Yeo") and further in view of U.S. Patent No. 6,558,499 issued to Pargass et al. (hereinafter "Pargass"). It is respectfully submitted that the Office Action has not established a prima facie case of obviousness, because the cited combination of Brandon, Yeo, and Pargass fails to teach or suggest all the claim limitations of claims 1 and 30.

The Office Action asserts that Brandon discloses the claimed invention except for a product comprising a package; at least n articles contained in the package, wherein n is greater than 10; and the printed graphic of each of the n articles is different from the graphic of the remaining articles. (See Office Action, Para. 15). In addition, the Office Action asserts that Brandon discloses that graphics can be different and discloses many selections of different graphics, thus providing motivation for different graphics. (See Office Action, page 5, Para. 15). However, Brandon does not disclose different graphics on diapers contained in a package. As such, the Office Action committed error by providing no reasoning as to why one of ordinary skill in the art would modify Brandon include a package containing 10 or more of the diapers of Brandon, each diaper including a printed graphic, and wherein the

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printed graphic of each of the n diapers is different from the graphic of each of the remaining diapers. The obviousness inquiry requires a determination of “whether there was an apparent reason to combine the known elements in the fashion claimed . . . . To facilitate review, this analysis should be made explicit.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citations omitted) (emphasis added). Here, without more, the Office Action erroneously concludes that the mere disclosure that graphics can be different provides motivation for different graphics on articles contained in a package.

Next, the Office Action cites Pargass as disclosing different graphics printed directly on backsheets. As discussed above, claim 1 is amended herein to further clarify that the graphics are printed directly on the backsheet (as opposed to a patch connected with the backsheet) by reciting that the microporous film material extends from the first waist region to the second waist region. In particular, claim 1 recites a backsheet comprising a microporous film material extending from the first waist region to the second waist region and having a body facing surface and a graphic printed directly on the garment facing surface of the microporous film material. (emphasis added). Claim 30 recites a backsheet comprising a sheet of material extending from the first waist region to the second waist region and a printed graphic printed directly on the sheet of material. (emphasis added).

In contrast to claims 1 and 30, Pargass discloses a diaper having a graphic printed on a patch, which may be joined with a backsheet. More particularly, Col. 8, ll. 47-48 of Pargass states: “Fig. 4a shows a method for making an appliqué layer 26 by placing a graphic 21 on a moving non-woven web, which forms the backsheet to the absorbent article.” (emphasis added). For clarity, Figures 4A and 5A of Pargass are reproduced below with reference numbers of particular interest being circled.

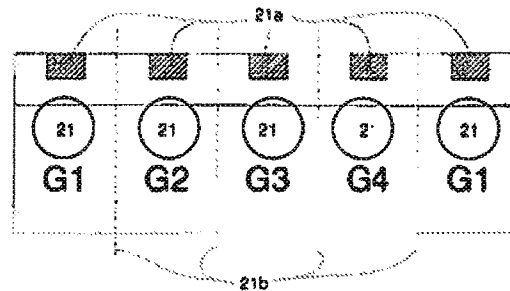


FIG. 5A

With regard to Figure 5A, Pargass discloses that the graphics 21 are provided from a first MD continuously moving layer or master roll 32, which has a plurality of graphics 21 and a corresponding plurality of reference markers 21a printed thereon. (*See* Col. 8, ll. 51-55). With further regard to Figure 4A, Pargass describes in more detail a method by which the graphics are applied to a nonwoven outer layer 22.

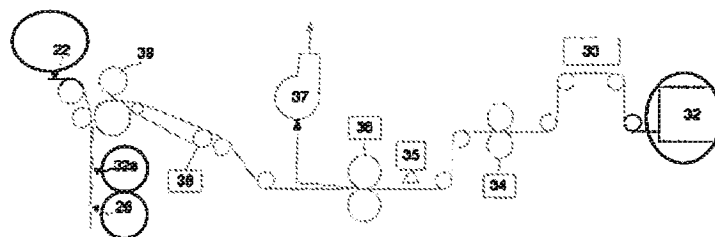


FIG. 4A

In particular, Pargass discloses that the continuously moving master roll 32 is conveyed by conveyor 34 and a photo-eye or optical sensor 35 detects the reference markers 21a. Once the reference markers 21a have been sensed or detected, they can be removed by any suitable means, and once the reference markers 21a are removed, the master roll 32 (without any reference markers whatsoever) is conveyed forward by servodrive 38 to cutting means 39. At cutting means 39, master roll 32 is cut at predetermined locations 21b to form individual segments 32a, which are then applied to non-woven outer layer 22 to form applique layer 26. (emphasis added). (*See* Col. 9, ll. 26-35). In sum, the method of making absorbent articles in Pargass prints the graphics 21 on a continuously moving layer or master roll 32 and cut

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into individual segments 32a, which are applied to an outer layer 22. As such, Pargass does not teach or suggest printing graphics directly backsheets as recited claims 1 and 30.

As discussed above, Brandon does not teach or suggest a product including absorbent articles having different graphics printed thereon contained in a package, as recited in claims 1 and 30. And the Office Action has not provided motivation for modifying Brandon to include such claim limitations. In addition, Pargass does not does not teach or suggest printing graphics directly on backsheets or sheets as recited in claims 1 and 30. And modifying the backsheets of Brandon by including the printed patches the Pargass would not meet all the claim limitations recited in claims 1 and 30.

Yeo is cited as disclosing a microporous film. As such, Yeo does not correct the deficiencies discussed above with respect to Brandon and Pargass.

The Office Action also erroneously concludes that the limitation that the graphics are different from each other is drawn to the content of printed matter. (See Office Action, Paras. 18-20). It is respectfully submitted that a claim limitation relating to graphics that are different from each other is not drawn to the content of printed matter. (emphasis added). Instead, when taken in the context of language of the entirety of claims 1 and 30, limitations relating to absorbent articles having graphics different from each other contained in a package are drawn to structural differences, not merely the content of printed matter.

In addition, the Office Action concludes that the claimed common theme, i.e. the content of graphics, do not lend additional patentable weight because if articles were patented based on differences in graphics, multiple patents could issue indefinitely for the same article by simply changing the content of the graphic. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), see also *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741 (2007). Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter. (*In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983). Under section 103, the board

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cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable. (*Id.*) The obviousness inquiry requires a determination of “whether there was an apparent reason to combine the known elements in the fashion claimed . . . . To facilitate review, this analysis should be made explicit.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (citations omitted) (emphasis added). Here, the Office Action erroneously excises the claimed common theme from claims 1 and 30 without considering the claimed common theme in the context of the claims as a whole.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). For at least the reasons provided above, the Office Action has not produced a prima facie case of unpatentability of claims 1 and 30. As such, claims 1 and 30 are believed patentable under 35 U.S.C. § 103 over Brandon in view of Yeo, and further in view of Pargass.

Claims 9, 11, and 22 and claims 23, 24, and 32 depend from and include all the limitations of claims 1 and 30, respectively. As such, for at least the same reasons discussed above with reference to claims 1 and 30, claims 9, 11, 22-24, and 32 are also patentable under 35 U.S.C. § 103(a) over the cited references.

With further regard to the rejection of claim 11, it is respectfully submitted that the Office Action’s reasoning is erroneous. In particular, the Office Action states: “The examiner notes that selecting the number of articles to include in a package is a mental determination, i.e. the result of a mental process; however, mental processes or processes of human thinking are not patentable even if they have practical application.” (See Office Action, Para. 23). The Office Action continues, “By ways of example, if there were 121 or 122 articles in the package instead of 120 as claimed, a separate patent would not issue for the package containing 121 articles, therefore the number of articles in the package does not lend additional patentable weight.” (See Office Action, Para. 23). It is respectfully submitted that the Office Action’s assertion in Paragraph 23 is based upon subjective

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reasoning as to why a patent should or should not be granted, as opposed to objective rationale based on the law.

Further, claim 1 from which claim 11 depends, is drawn to an absorbent product comprising, among other limitations, a package and absorbent articles contained in the package. Claim 1 recites in part, a package and at least n absorbent articles contained in the package, wherein n is greater than 10. Claim 11 further defines n as being selected from 11 to 120. The number of absorbent articles contained in the package is a structural limitation of the absorbent product (i.e. the subject matter of the claims) and therefore does lend patentable weight. (emphasis added). Thus, it is respectfully submitted that the number of articles recited in claim 11 is not a mental process or a process of human thinking.

Therefore, it is believed that claims 1, 9, 11, 22-24, 30, and 32 are in form for allowance and such indication is respectfully requested.

Rejections Under 35 U.S.C. § 103 over Brandon in view of Yeo, Pargass, and Stavrulov

In the Office Action, claims 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Brandon in view of Yeo in view of Pargass and further in view of PCT Patent Publication No. WO00/13632 in the name of Stavrulov (hereinafter "Stavrulov").

As discussed above, it is believed claims 1 and 30 are patentable under 35 U.S.C. § 103(a) over the asserted combination of Brandon, Yeo, and Pargass. Stavrulov does not correct the deficiencies of Brandon, Yeo, and Pargass. Thus, claims 1 and 30 are believed patentable under 35 U.S.C. § 103(a) over the asserted combination of Brandon, Yeo, Pargass, and Stavrulov. Claims 33 and 34 depend from and include all the limitations of independent claims 1 and 30, respectively. As such, for at least the same reasons discussed above with reference to claims 1 and 30, claims 33 and 34 are also believed patentable under 35 U.S.C. § 103(a) over the cited references.

In addition, dependent claims 33 and 34 recite that the printed graphics are printed directly on each sheet of the n absorbent articles in a randomly selected order and the n absorbent articles are stacked in the package in the randomly selected order.

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The Office Action made various assertions that the aforementioned claim limitations do not patentably distinguish the claimed invention over the prior art. (See Office Action, Page 13).

The Office Action initially refers to claims 1 and 30, and in particular, the claimed predetermined association and common theme and asserts that these limitations are drawn to a mental process and therefore do not lend additional patentable weight. (See Office Action, Para. 31). It is respectfully submitted that the Office Action's rationale here is erroneous. The elements of "wherein the predetermined association includes a common theme" recited in claims 1 and 30 are not mental processes.

The Office Action also asserts that the decision of how to package diapers in randomly selected orders or non-randomly selected orders is not a structural limitation, but rather is the result of a mental process. (See Office Action, Page 10, Para. 32). In contrast to the Office Action's assertions, claims 33 and 34 do not recite a mental process as to how to decide to package absorbent articles. Instead, claims 33 and 34 recite the structural limitations that define the  $n$  absorbent articles as being stacked in the package in the randomly selected order.

Claims 1 and 30 recite an absorbent product comprising, among other elements, a package and at least  $n$  absorbent articles contained in the package. Claims 33 and 34 recite structural limitations in that the  $n$  absorbent articles are stacked in the package in the randomly selected order. In contrast to the Office Action's assertion, an absorbent product having absorbent articles stacked in a package in a randomly selected order is not merely a mental process.

The Office Action also asserts that the articles of Brandon are capable of being placed in a randomly selected order. (See Office Action, Paras. 33-34). It is respectfully submitted that an assertion that the prior art can be modified, without more, does not render does not render the pending claims obvious. (See MPEP 2143.01).

In addition, the Office Action asserts that the structural elements of the diapers do not change if the order in the package is rearranged differently thus the order in which the

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diapers are placed in the package does not affect the diaper structure, and therefore, this limitation does not lend additional patentable weight. (See Office Action, Para. 33). It is respectfully submitted that the Office Action's reasoning is erroneous. Claims 1 and 30 are drawn to absorbent products comprising, among other limitations, a package and absorbent articles contained in the package. The order in which the absorbent articles are arranged in the package is a structural limitation of the absorbent product (i.e. the subject matter of the claims) and therefore does lend patentable weight. (emphasis added).

The Office Action also asserts that "if products were patented based on simply changing the order in which they are placed in a package, multiple patents could issue indefinitely for the same product merely by placing them in a package in a different order." (See Office Action, Para. 34). It is respectfully submitted that the Office Action's assertion in Paragraph 34 is based upon subjective reasoning as to why a patent should or should not be granted, as opposed to objective rationale based on the law.

Next, the Office Action asserts that in view of the teachings of Stavrulov, it would have been obvious to modify Brandon, Yeo, and Pargass to include graphics printed in a randomly selected order. (See Office Action, Paras. 43-46). The prior art must be considered in its entirety, including disclosures that teach away from the claimed invention, and it is improper to combine references where the references teach away from their combination. (See MPEP 2145 X.D.). In contrast to claims 33 and 34, Pargass teaches articles with distinct repeating graphics in packages. (emphasis added). (See Col. 5, ll. 2-6; and Col. 15, ll. 58-63). As such, Pargass teaches away from the claimed invention as well as the asserted combination with Stavrulov.

If examination at the initial stage does not produce a prima facie case of unpatentability, then without more the applicant is entitled to grant of the patent. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). For at least the reasons provided above, the Examiner has not produced a prima facie case of unpatentability of claims 33 and 34. As such, claims 33 and 34 are believed patentable under 35 U.S.C. § 103 over Brandon in view of Yeo, Pargass, and further in view of Stavrulov.



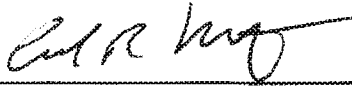
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Conclusion

In view of the foregoing, reconsideration of this application and allowance of the pending claims are respectfully requested.

Respectfully submitted,

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